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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,002	07/09/2003	Blaine R. Southam	200209006-1	3099

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FORT COLLINS, CO 80527-2400

EXAMINER
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JEAN GILLES, JUDE

ART UNIT	PAPER NUMBER
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2143

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/03/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/617,002

Applicant(s)

SOUTHAM, BLAINE R.

Examiner

Jude J. Jean-Gilles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This office action is responsive to communication filed on 07/09/2003.

#### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 115, and 24 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 9, 16, and 22 of U.S. Patent No. 6,920,410. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are directed to a similar method and system of testing a network service using the same steps and limitations.

Furthermore, Claims 1, 15, and 24 of this application conflict with claims 1, 9, 17, 21, 25, and 28 of Application No. 10/615547. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik et al (hereinafter Malik) U.S. Patent No. 6,160,794 in view of Cohen et al (hereinafter Cohen) U.S. Patent No. 6,389,462 B1.

**Regarding claim 1:** Malik discloses the invention substantially as claimed. Malik teaches an A method for collecting data regarding network service operation, the method comprising:

intercepting a message directed to a network service (column 10, lines 57-67); and  
transmitting the message to a destination network service;

however Malik does not specifically disclose the details of "storing information about the message prior to transmitting the message to its destination network service".

In the same field of endeavor, Cohen discloses "*...if the requested object is stored in the cache, a copy of that object is transparently returned to the requesting client. A TCP connection, therefore, is not established over the Internet 105, to the actual origin server 107 to provide the requested object to the requesting client. The cost of transmitting the request to the origin server over the Internet and transmitting the copy of the requested object back over the Internet are thereby saved in addition to the time required for transmitting such a request over the Internet and waiting for a response from the origin server ...*" [see Cohen; column 7, lines 18-27].

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Cohen's teachings of storing information about the message with the teachings of Malik, for the purpose of

improving the ability of a network "...to *provide* method of transparently intercepting client web requests and redirecting them to proxy caches in order to decrease both the latency of object retrieval and traffic on the Internet backbone..." as stated by Cohen in lines 7-15 of column 1. By this rationale, **claim 1** is rejected.

**Regarding claim 2:** the combination Malik-Cohen discloses the method of claim 1, wherein intercepting a message comprises intercepting a message sent by a developed network service [see Malik; column 1, lines 32-40; olumn 12-21].

**Regarding claim 3:** the combination Malik-Cohen discloses the method of claim 1, wherein intercepting a message comprises intercepting a message using a network proxy that is intermediate the client and the destination network service [see Cohen; fig. 1; column 6, lines 22-46].

**Regarding claim 4:** the combination Malik-Cohen discloses the method of claim 1, wherein storing information about the message comprises storing information about the message using a network proxy [see Cohen; column 7, lines 18-27; column16, lines 51-67].

**Regarding claim 5:** the combination Malik-Cohen discloses the method of claim 4, wherein storing information about the message comprises storing information about at least one of a time the message was received, an identity of the client that sent the message, an identity of the destination network service, a time at which the message

was transmitted to the destination network service, and information about the substance of the message [see Cohen; column 7, lines 18-27; column 16, lines 51-67].

**Regarding claim 6:** the combination Malik-Cohen discloses the method of claim 1, wherein transmitting the message to a destination network service comprises transmitting the message to an external network service [see Cohen; fig. 1; column 6, lines 22-46].

**Regarding claim 7:** the combination Malik-Cohen discloses the method of claim 1, wherein transmitting the message to a destination network service comprises transmitting the message to a mock network service that emulates operation of an external network service [see Malik; column 1, lines 32-40; column 12-21].

**Regarding claim 8:** the combination Malik-Cohen discloses the method of claim 1, further comprising interjecting instrumentation information into the message prior to transmitting the message to the destination network service [see Malik; column 10, lines 57-67].

**Regarding claim 9:** the combination Malik-Cohen discloses the method of claim 8, wherein interjecting instrumentation information comprises interjecting instrumentation information using a network proxy that is intermediate the client and the destination network service [see Cohen; fig. 1; column 6, lines 22-46].

**Regarding claim 10:** the combination Malik-Cohen discloses the method of claim 9, wherein interjecting instrumentation information comprises adding instrumentation information to a header of the message [see Cohen; column 7, lines 18-27; column16, lines 51-67].

**Regarding claim 11:** the combination Malik-Cohen discloses the method of claim 9, wherein interjecting instrumentation information comprises interjecting at least one of a time the message was received, an identity of the client that sent the message, an identity of the destination network service, a time at which the message was transmitted to the destination network service, and information about the substance of the message[see Cohen; column 7, lines 18-27; column16, lines 51-67].

**Regarding claim 12:** the combination Malik-Cohen discloses the method of claim 11, further comprising receiving a response from the destination network service and storing data regarding the response [see Cohen; column 7, lines 18-27; column16, lines 51-67].

**Regarding claim 13:** the combination Malik-Cohen discloses the method of claim 12, wherein storing data regarding the response comprises storing data using a network proxy through which the response is routed [see Cohen; column 7, lines 18-27; column16, lines 51-67].



**Regarding claim 14:** the combination Malik-Cohen discloses the method of claim 13, wherein storing data regarding the response comprises storing at least one of a time the response was received, an identity of the destination network service, a time that the message transmitted to the destination network service was received, and a time that the response was transmitted by the destination network service [see Cohen; column 7, lines 18-27; column 16, lines 51-67].

**Regarding claim 15:** the combination Malik-Cohen discloses a system for collecting data regarding network service operation, the system comprising: means for intercepting a message directed to a network service; means for storing information about the message; means for interjecting instrumentation into the message; and means for transmitting the message to a destination network service [see Cohen; column 7, lines 18-27; column 16, lines 51-67].

**Regarding claim 16:** the combination Malik-Cohen discloses the system of claim 15, wherein the means for intercepting a message comprise a network proxy that is intermediate the client and the destination network service [see Cohen; fig. 1; column 6, lines 22-46].

**Regarding claim 17:** the combination Malik-Cohen discloses the system of claim 15, wherein the means for storing information comprise means for storing information about

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at least one of a time the message was received, an identity of the client that sent the message, an identity of the destination network service, a time at which the message was transmitted to the destination network service, and information about the substance of the message [see Cohen; column 7, lines 18-27; column16, lines 51-67].

**Regarding claim 18:** the combination Malik-Cohen discloses the system of claim 15, wherein the means for interjecting instrumentation information comprise a network proxy that is intermediate the client and the destination network service [see Cohen, fig. 1].

**Regarding claim 19:** the combination Malik-Cohen discloses the system of claim 15, wherein the means for interjecting instrumentation information comprise means for adding instrumentation information to a header of the message [see Cohen; column 7, lines 18-27; column16, lines 51-67].

**Regarding claim 20:** the combination Malik-Cohen discloses the system of claim 15, wherein the means for interjecting instrumentation information comprise means for interjecting at least one of a time the message was received, an identity of the client that sent the message, an identity of the destination network service, a time at which the message was transmitted to the destination network service, and information about the substance of the message [see Cohen; column 7, lines 18-27; column16, lines 51-67].

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**Regarding claim 21:** the combination Malik-Cohen discloses the system of claim 15, further comprising means for storing data regarding a response received from the destination network service [see Cohen; column 7, lines 18-27; column16, lines 51-67].

**Regarding claim 22:** the combination Malik-Cohen discloses the system of claim 21, wherein the means for storing data regarding a response comprise a network proxy [see Cohen; column 7, lines 18-27; column16, lines 51-67].

**Regarding claim 23:** the combination Malik-Cohen discloses the system of claim 21, wherein the means for storing data regarding the response comprise means for storing at least one of a time the response was received, an identity of the destination network service, a time that the message transmitted to the destination network service was received, and a time that the response was transmitted by the destination network service[see Cohen; column 7, lines 18-27; column16, lines 51-67].

**Regarding claim 24:** the combination Malik-Cohen discloses a network proxy stored on a computer-readable medium, the proxy comprising: logic configured to intercept messages directed to a network service; logic configured to store information about the message; and logic configured to transmit the message to a destination network service [see Cohen; column 7, lines 18-27; column16, lines 51-67].

**Regarding claim 25:** the combination Malik-Cohen discloses the network proxy of

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claim 24, wherein the logic configured to store information about the message comprises logic configured to store information about at least one of a time the message was received, an identity of the client that sent the message, an identity of the destination network service, a time at which the message was transmitted to the destination network service, and information about the substance of the message [see Cohen; column 7, lines 18-27; column16, lines 51-67].

**Regarding claim 26:** the combination Malik-Cohen discloses the network proxy of claim 24, wherein the logic configured to transmit is configured to transmit the message to one of an external network service and a mock network service that emulates operation of the external network service [see Malik; column 1, lines 32-40; column 12-21].

**Regarding claim 27:** the combination Malik-Cohen discloses the network proxy of claim 24, further comprising logic configured to interject instrumentation information into the message [see Cohen; column16, lines 28-67].

**Regarding claim 28:** the combination Malik-Cohen discloses the network proxy of claim 27, wherein the logic configured to interject instrumentation information comprises logic configured to add instrumentation information to a header of the message [see Cohen; column16, lines 28-67].

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**Regarding claim 29:** the combination Malik-Cohen discloses the network proxy of claim 27, wherein the logic configured to interject instrumentation information comprises logic configured to interject at least one of a time the message was received, an identity of the client that sent the message, an identity of the destination network service, a time at which the message was transmitted to the destination network service, and information about the substance of the message [see Cohen; column 7, lines 18-27; column 16, lines 51-67].

**Regarding claim 30:** the combination Malik-Cohen discloses the network proxy of claim 24, further comprising logic configured to receive a response from the destination network service and logic configured to store data regarding the response [see Cohen; column 16, lines 28-67].

**Regarding claim 31:** the combination Malik-Cohen discloses the network proxy of claim 30, wherein the logic configured to store data regarding the response comprises logic configured to store at least one of a time the response was received, an identity of the destination network service, a time that the message transmitted to the destination network service was received, and a time that the response was transmitted by the destination network service [see Cohen; column 7, lines 18-27; column 16, lines 51-67].

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**Conclusion**

4. **THIS ACTION IS MADE NON-FINAL.** The Examiner strongly anticipates a Final Rejection Office Action on the next response if amendments are not properly made to the claims to perhaps place them in condition for allowance.

Any inquiry concerning this communication or earlier communications from examiner should be directed to Jude Jean-Gilles whose telephone number is (571) 272-3914. The examiner can normally be reached on Monday-Thursday and every other Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3719.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

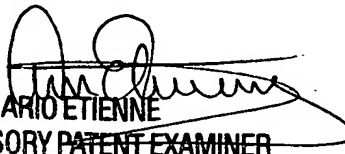
Jude Jean-Gilles

Patent Examiner

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JJG

December 23, 2006

  
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